

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named
Inventor : Arnaud Capitant et al.
Appln. No. : 09/332,489
Filed : June 14, 1999
Title : PROCESS FOR MAKING REMOTE
PAYMENTS FOR THE PURCHASE OF
GOODS AND/OR A SERVICE THROUGH A
MOBILE RADIOTELEPHONE, AND
CORRESPONDING SYSTEM AND MOBILE
RADIOTELEPHONE

Appeal No. *1211-83*

Group Art Unit: 3621

Examiner: Firmin Backer

Docket No. : S828.312-0002

RECEIVED

DEC 02 2003

GROUP 3600

BRIEF FOR APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I CERTIFY THAT THIS PAPER IS BEING SENT BY U.S. MAIL,
FIRST CLASS, TO THE COMMISSIONER FOR PATENTS,
ALEXANDRIA VIRGINIA 22313-1450, THIS 21st DAY OF

November

2003.

[Signature]
PATENT ATTORNEY

Sir:

This is an appeal from an Office Action dated April 4, 2003 in which claims 1-22 were finally rejected, based upon a Notice of Appeal filed September 29, 2003.

Real Party in Interest

The real party in interest is Société Française du Radiotéléphone, a corporation organized and existing under the laws of France, and having offices at 1, Place Carpeaux, Paris La Defense Cedex, Paris, France, who is the owner of the entire right, title and interest in the application.

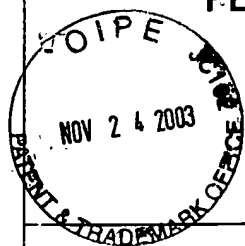
Related Appeals and Interferences

There are no known related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

11/28/2003 BABRAHA1 00000063 09332489

01 FC:1402

330.00 0P



FEE TRANSMITTAL

Total Amount of Payment \$330.00

Complete if Known

Application No. 09/332,489
Filing Date June 14, 1999
First Named Inventor Arnaud Capitant et al.
Group Art Unit 3621
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METHOD OF PAYMENT (Check One)

1. ☒ The Commissioner is hereby authorized to charge any additional fee required under 37 C.F.R. 1.16 and 1.17 and credit any over payments to Deposit Account No.11-0982. Deposit Account Name: Kinney & Lange, P.A. A duplicate copy of this communication is enclosed

2. ☒ Check Enclosed

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description
1001	770	2001	385	<input type="checkbox"/> Utility Filing Fee
1002	340	2002	170	<input type="checkbox"/> Design Filing Fee
1004	770	2004	385	<input type="checkbox"/> Reissue Filing Fee
1005	160	2005	80	<input type="checkbox"/> Prov. Filing Fee

Subtotal (1) \$0.00

2. EXTRA CLAIM FEES

	Number Claims	Prior**	Extra	Fee from Below	Fee Paid
Total	*	*	=	* X	* = *
Indep.	*	*	=	* X	* = *
Multiple Dependent Claims				*	= *

**Insert 3 and 20, or number previously paid if greater; Reissue see below

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple Dependent Claim
1204	86	2204	43	Reissue Independent Claims Over Original Patent
1205	18	2205	9	Reissue claims in excess of 20 and over original patent

Subtotal (2) \$0.00

FEE CALCULATION (Continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee paid
1051	130	2051	65	Surcharge - Late filing fee or oath	*
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	*
1053	130	1053	130	Non-English specification	*
1812	2,520	1812	2,520	For Filing a Request for Reexamination -	*
1251	110	2251	55	Extension for reply within first month	*
1252	420	2252	210	Extension for reply within second month	*
1253	950	2253	475	Extension for reply within third month	*
1254	1,480	2254	740	Extension for reply within fourth month	*
1255	2,010	2255	1,005	Extension for reply within fifth month	*
1402	330	2402	165	Filing a brief in support of an appeal	330
1403	290	2403	145	Request for oral hearing	*
1814	110	2814	55	Terminal Disclaimer Fee	*
1452	110	2452	55	Petition to revive - unavoidable	*
1453	1,330	2453	665	Petition to revive - unintentional	*
1501	1,330	2501	665	Utility/Reissue issue fee	*
1502	480	2502	240	Design issue fee	*
1460	130	1460	130	Petitions to the Commissioner	*
1807	50	1807	50	Petitions related to provisional applications	*
1806	180	1806	180	Submission of Information Disclosure Statement	*
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	*
1801	770	2801	385	Request for Continued Examination (RCE)	*
Other fee (specify) _____					*

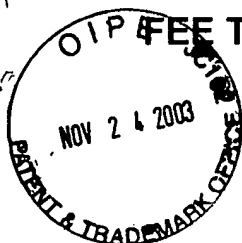
Subtotal (3) \$330.00

Signature Jeffrey D. Shewchuk

Reg. No. 37,235

Date November 21, 2003

Deposit Account No. 11-0982



Total Amount of Payment \$330.00

METHOD OF PAYMENT (Check One)

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1005	160	2005	80	<input type="checkbox"/> Prov. Filing Fee

Subtotal (1) \$0.00

2. EXTRA CLAIM FEES

	Number Claims	Prior**	Extra	Fee from Below	Fee Paid
Total	*	-	*	=	*
Indep.	*	-	*	=	*
Multiple Dependent Claims			*	=	*

**Insert 3 and 20, or number previously paid if greater; Reissue see below

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GROUP 360

FEE CALCULATION (Continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee paid
1051	130	2051	65	Surcharge - Late filing fee or oath	*
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	*
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Other fee (specify) _____

Subtotal (3) \$330.00

Signature

Jeffrey D. Shewchuk

Reg. No.

37,235

Date

November 21, 2003

Deposit Account No.

11-0982

Status of the Claims

- I. Total number of claims in the application:
- Claims in the application are: 1-22, inclusive.
- II. Status of all the claims:
- | | | |
|----|--|-------|
| A. | Claims cancelled: | None. |
| B. | Claims withdrawn but not canceled: | None. |
| C. | Claims pending: | 1-22. |
| D. | Claims allowed: | None. |
| E. | Claims rejected: | 1-22. |
| F. | Claims objected to, indicated as being allowable if rewritten into independent form including all of the limitations of the base claim and any intervening claims: | None. |
- III. Claims on appeal
- A. The claims on appeal are: 1-22.

Status of Amendments

No Amendment After Final was filed in this matter. However, a Response After Final was filed on July 3, 2003, together with a petition for One-month Extension of Time and the associated Extension of Time fee. It was indicated by an Advisory Action mailed on August 4, 2003 that the Response After Final was considered but did not place the application in condition for allowance and was not entered.

Summary of Invention

The present invention is a process for making remote payments for the purchase of goods and/or a service using a mobile radiotelephone. (*See Application, p. 1, lines 1-2*). The invention is applicable to all types of mobile radiotelephones, including those with a terminal only and

those with a terminal that cooperates with a subscriber identification module (SIM). (*See* Application, p. 1, lines 5-7). It is assumed that remote payment for goods or services through a mobile radiotelephone is made through a closed-type of radio communications network (such as GSM 900, DCS 1800, and the like). (*See* Application, p. 2, lines 7-11). Platforms or gateways connect closed-type of radio communications networks with open-type communications networks (such as the Internet). (*See* Application, p. 3, lines 12-20). In general, the mobile radiotelephone enables access to the closed radio communications network managed by a management center. (*See* Application, p. 2, line 34 through p. 3, line 1). A payment server is also connected to the closed radio communication network. (*See* Application, p. 3, lines 1-2). The process of the present invention involves "identification of the said buyer by the said management center and/or the said payment server and/or a control center", such that at the end of the buyer identification step, the payment server manager is "assured that the buyer is a bona fide member of the radio communications network to which the payment server is connected." (*See* Application, p. 3, lines 2-10). Preferably, the buyer identification step includes subscriber identification and subscriber authentication. (*See* Application, p. 3, lines 18-27). Thus, the present invention utilizes the security provided by the physical layers of the closed network, as opposed to open network security which is typically applied at an application level. (*See* Application, p. 3, lines 28-34).

As shown in FIG. 1, the user 2 utilizes a mobile radiotelephone 1 to access a closed radio communications network 5 via a radio relay link 3. The closed radio communications network 5 is managed by a management center 6. The closed radio communications network 5 is connected to an open communications network 9 (the Internet network 9) via a gateway 10. The payment server 4 and the sales server 8, both on the open communications network 9, are connected to the closed radio communications network 5 via the gateway 10.

In this case, the mobile radiotelephone is provided with a navigator (for example a "UP Browser" (registered trademark) navigator marketed by the Unwired Planet Company) which enables it to navigate through the gateway within the Internet network and particularly to access the payment server 4 and the sales server 8.

Application, p. 9, lines 10-14. The system enables a buyer 2 to make a secure remote payment for goods and/or services that he or she has purchased from the remote sales server 8 of the supplier 7.

Finally, the authentication and purchase process can be understood in detail in light of FIG. 5 and the accompanying description beginning at page 11, line 5. In particular, FIG. 5 illustrates an embodiment that the applicant would expect to become the conventional implementation. In particular, the radiotelephone 1 sends the user's subscriber identifier 50 to the management center 6. (*See* Application p. 11, lines 7-8). The management center 6 then transmits a random number ("RAND") 51a to the radiotelephone 1. (*See* Application, p. 11, lines 10-11). Using an algorithm ("A3/A8") 23b and an individual authentication key ("Ki") 23c, the radiotelephone 1 calculates an electronic signature. (*See* Application, p. 11, lines 11-14). The electronic signature 51b is sent to the management center 6, which checks the received electronic signature with a locally calculated electronic signature. (*See* Application, p. 11, lines 15-17). If the two signatures are identical, the management center sends messages 51C and 52 to confirm this to the radiotelephone 1 and to an identification module 40 located in the payment server. (*See* Application, p. 11, lines 17-22).

When the buyer 2 sends a purchase request 53 to the sales server 8 of the supplier 7, the sales server transmits data about the price of the goods and/or service 54 from the sales server 8. (*See* Application, p. 12, lines 32-33). The buyer makes a purchase decision 55. (*See* Application, p. 12, lines 33-34). The mobile telephone 1 transmits the buyer's purchase decision and his/her electronic signature (reference numeral 56) firstly to the sales server 8 and secondly the payment server 4. *See* Application, p. 12, line 36 through p. 13, line 3). If the payment server 4 accepts the transaction, a "transaction accepted" message 58 is sent to the sales server 8, and the sales server 8 sends a purchase confirmation 58 to the buyer. (*See* Application, p. 13, lines 7-11).

In summary, in the embodiment described above, the system of the present invention utilizes the closed-network identification and authentication scheme to form a basis for trust with the mobile phone user. When the mobile phone user makes a purchase on the open network using his or her mobile phone, the electronic signature generated by the identification/authentication process

is used to authorize payment from the payment server to a sales server on the open network through the identification message 52 sent by the management center to the payment center.

Issues

A. Whether the combination of the teachings of the Fournies patent and the Wagner patent result in the claimed invention, rendering the invention obvious under 35 U.S.C. §103(a).

B. Whether there is any suggestion to combine the teachings of the Fournies patent with those of the Wagner patent.

C. Whether the Fournies patent discloses or suggests the invention of claim 3.

D. Whether the Fournies patent discloses or suggests the invention of claims 6 or 7.

E. Whether the Fournies patent discloses or suggests the invention of claim 8.

F. Whether the Fournies patent discloses or suggests the invention of claim 9.

G. Whether the Fournies patent discloses or suggests the invention of claim 14.

H. Whether the Fournies patent discloses or suggests the invention of claim 19.

Grouping of Claims

The following groupings of claims are made solely in the interest of consolidating issues and expediting this Appeal. No grouping of claims is intended to be nor should be interpreted as being any form of admission or a statement as to the scope or obviousness of any limitations.

I. Claims 1, 2, 4, 5, 10-13, 15-18 and 20-22 stand or fall alone.

II. Claims 3 and 15 stand or fall alone.

III. Claims 6 and 7 stand or fall alone.

IV. Claim 8 stands or falls alone.

V. Claim 9 stands or falls alone.

VI. Claim 14 stands or falls alone.

VII. Claim 19 stands or falls alone.

Argument

A. FOUNGIES '851 AND WAGNER'967, EVEN IF COMBINED, DO NOT RESULT IN THE INVENTION OF CLAIM 1.

In the present invention, the Applicant is concerned with the problem of facilitating purchases of goods and services from servers on an open network by a mobile telephone user connected to a closed network. In particular, the Applicant recognized that the identification/authentication process of the closed network is duplicated by payment servers (and the like) on the open network. The present invention uses the identification/authentication process for establishing a connection between a mobile telephone and a closed radiotelephone network in order to authenticate payments for purchases made using the mobile telephone over an open network, such as the Internet. Specifically, claim 1 requires, based on a request from the supplier within the open network, that the management center (and/or payment server and/or control center) of the closed radiotelephone network verifying to the requester that the buyer is a subscriber correctly registered on a list of subscribers to the closed radio communications network. Thus, by utilizing the identification/authentication process of the closed type network to facilitate authorization of payments on the open network, the present invention streamlines the process of making purchases using mobile telephones, reduces the number of keystrokes required to make a purchase by the user of the mobile telephone, and enhances the security of remote mobile telephone purchases by utilizing digital keys and/or digital signatures.

Fougnes '851 is directed to a very different problem than that of the subject application. Specifically, Fougnes '851 is directed to a system for providing prepaid cellular services and for allowing current pre-paid subscribers to purchase additional air time. Fougnes '851 describes the problem as follows:

“Up to now, the cellular service provider had no means available to offer cellular telecommunications services on a prepaid basis, monitor the subscriber's cellular telecommunications usage in real time and discontinue

access to the cellular telecommunications services immediately upon exhaustion of a prepaid account balance.

Also, to date, **cellular service providers do not have a means to allow current pre-paid subscribers to purchase additional air time and pay for additional monthly access fees in real time at a purchase point** other than a cellular service center in order to provide continued use of the cellular service to the subscriber.”

Fougnies ‘851, Col. 1, lines 47-63 (emphasis added).

In contrast to the process for making remote payments of the present invention, which utilizes the mobile telephone identification/authentication process for authorization to make purchases over the open network, Fougnies ‘851 utilizes a pre-selected telephone number reserved for the cellular provider for initiating a telephone call to a destination number. Specifically, Fougnies ‘851 describes the process as follows:

“The present invention provides a system and method which recognizes cellular radiotelephones pre-programmed with **a pre-selected telephone number and an automated number identification code (ANI)**. **The pre-selected telephone number is reserved to the prepaid cellular telecommunications system. The user merely enters the destination telephone number and activates an off-hook condition, typically by depressing a "send" button on the keypad of the cellular radiotelephone. The cellular radiotelephone then transmits the ANI and a dialed number identification system code (DNIS)**. Because all cellular systems operate on the basis of discrete cell sites, which re-transmit the received signal to a central cellular service organization cellular switch, both the ANI and the DNIS are transmitted to the cellular switch. At the cellular switch, the ANI is recognized as one reserved to the pre-paid cellular system and is re-directed, along with the DNIS, to the pre-paid cellular system switch via T1 land lines or via cellular re-transmission.

At the pre-paid cellular system switch, a host computer authenticates both the ANI and DNIS. Upon recognition of a valid ANI, the host computer establishes communications via either a local area network (LAN) or wide-area network (WAN) with a remote computer database server. At the remote computer database server, a database is maintained with pre-paid subscriber information. The pre-paid subscriber database contains records of each pre-paid subscriber. Each subscriber record in the database includes, at least the ANI assigned to that pre-paid subscriber, a pre-paid account balance and a

time rate for telecommunications charges.

The host computer validates the received ANI by comparison to the ANI information in the database. Upon validation of the received ANI, account balance information for the account associated with the received ANI is queried to determine if there is a positive credit balance. Upon verification that the account has a positive credit balance, the host computer out pulses the dialed destination telephone number to a local exchange carrier, such as one of the Regional Bell Operating Companies.”

Fournies ‘851, Col. 1, line 53 through Col. 2, line 25 (emphasis added). Thus, Fournies ‘851 debits a pre-paid account of the cellular service by routing telephone calls through the pre-paid service server and tracking the “off-hook” condition. Fournies ‘851 is directed entirely to the process of establishing a point-to-point connection between a caller terminal and a destination terminal.

Furthermore, the pre-paid services mentioned in Fournies ‘851 involve “calling cards” that are “printed, bundled and made widely available at outlets such as convenience stores, grocery stores, etc.” *See* Fournies ‘851, Col. 11, lines 62-64. Moreover, the calling cards are “sold in fixed denominations so that a subscriber can purchase a specific number of cards in order to raise their account to a desired balance.” *See* Fournies ‘851, Col. 11, lines 64-67. Fournies ‘851 then eliminates “the need for the user to make unnecessary dialing entries” thereby allowing the user to enter only the destination number, providing “transparent call processing for the end-user”. *See* Fournies ‘851, Col. 13, lines 51-61. Thus, Fournies ‘851 is directed to a process for pre-payment of a cellular user in order for the user to connect with a cellular network. Fournies ‘851 discloses a way to allow only pre-authorized users to complete cellular telephone calls and only within the closed network. *See Col. 7, lines 14-22*. More specifically, Fournies ‘851 allows users to purchase air time in the form of pre-paid cards for use with the closed network in order to make and receive telephone calls. *See Col. 11, line 57 through Col. 12, line 21*. Operating totally within a closed network, the functionality described in Fournies ‘851 has little to do with the present invention.

Fournies ‘851 does not disclose or suggest using a cellular telephone to make purchases of anything other than more telephone access time on the cellular telephone network. Fournies ‘851 has nothing at all to do with permitting the cellular telephone user to purchase separate

goods or services. Additional telephone access time cannot be considered a separate good or service, because the cellular telephone user would not be a cellular telephone user in the first place without purchasing access time (i.e., the purchase of cellular telephone access time is subsumed in the definition of cellular telephone user). Fournies '851 has nothing at all to do with permitting the cellular telephone user to purchase anything from a third party. Fournies '851 has nothing at all to do with permitting the cellular telephone user to purchase anything on an open-type network.

In fact, the Fournies patent is a good example of the prior art cited in the specification of the present invention. Since closed radiocommunications networks do not enter into the category of open data processing (computer) telecommunications networks, the content and solution recommended by the Fournies patent cannot be applied to the problem solved by the present invention, specifically remote payment for goods and services on an open network using a closed network radiotelephone. In the Fournies patent, there is no way at all to communicate outside the closed radiocommunications network with a payment server or a sales server located within an open network.

While the Fournies patent provides a secure way to allow establishment of a telephone call, the first step of the process of the present invention begins only after getting the allowance for the call. Claim 1 is limited to a process for remote and secure payment for goods and/or a service purchased by a buyer from a supplier within an open network, making use of a mobile radiotelephone within a closed radiocommunications network used by the buyer. In other words, the active steps of the present invention as defined by claim 1 begins after the call on the mobile radiotelephone within a closed radiocommunications network has been established. Fournies does not disclose or suggest any remote and secure payment for goods and/or a service after the call on the mobile radiotelephone within a closed radiocommunications network has been established. In fact, Fournies does not disclose or suggest any steps after the call on the mobile radiotelephone within a closed radiocommunications network has been established. Specifically - after the call on the mobile radiotelephone within a closed radiocommunications network has been established - claim 1 requires "identification of the buyer by the management center and/or the payment server and/or a control

center based on a request from the supplier within the open network". In the Fournies patent, there is no disclosure relating to communication with payment or sales servers located outside the closed telecommunications network, such as a payment server located within an open network.

Recognizing that Fournies '851 teaches nothing whatsoever about open-type networks (much less using a closed network to facilitate a purchase on the open network), the final rejection looks to Wagner '967, stating, "Wagner teaches a supplier within an open network. (See fig 13A, column 5 lines 29-42). Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to modify Fournies et al's inventive concept to include Wagner's concept of a supplier within an open network because this would have supported electronic transaction or data compilation in a secure manner without undue limitation as to the devices with which communication may be made." Applicant fully admits that it did not invent open networks, or suppliers within an open network. Suppliers within an open network are necessary for the present invention to have application, but the mere existence of a supplier within an open network does not remotely suggest the present invention. The statement that "Wagner teaches a supplier within an open network" is of no significance to the present invention, because Applicant does not claim to have invented suppliers within an open network.

Wagner '967 is far removed from the art of the present invention. Wagner '967 is directed to "data transaction systems, and more particularly, to data transaction systems using non-standard input/output devices." See Wagner '967, Col. 1, lines 16-18. Specifically, Wagner '967 addresses a problem with respect to non-standard input/output devices being able to effectively communicate with a server on the open network, such as the Internet. See Wagner '967, Col. 5, lines 29-42. In particular, Wagner '967 proposes to add "tags" to the standards for controlling terminal operations remotely. See Fig. 5, item 140, and Col 13, line 54 through Col. 14, line 12. Simply put,

"commands which are compatible with the communication schema of a presently-implemented protocol for the Internet are used and additions are made to commands implemented with the control structure of that existing protocol to support non-standard I/O device communication."

Col. 5, line 64 through Col. 6, line 1.

Terminals are Internet connected either directly or connected to a PC or another terminal itself Internet connected. Wagner '967, via the use of a "tag", allows for triggering a banking PIN capture on a terminal dedicated to a transaction with a banking server. The Wagner tag notion has absolutely nothing to do with the present invention. Wagner makes no mention or notion of a closed network.

The architecture disclosed in Wagner '967 is also fundamentally different from that of the present invention (See FIG. 1 and Col. 9, line 66- col. 10, line 19). In the present invention, HTML tags and the HTML language in general is undesirable, in part, because terminals are standards. The present invention operates at the server level (management, payment, control, etc.) where the reality and effectiveness of the transaction are checked with different means for the vendor.

In Wagner '967 (and not at all in the present application), a "payment" tag is used to trigger a payment on a banking protocol. Instead, the present invention authenticates a payment via a payment PIN code, cryptography or even an electronic signature (checked and authenticated by the management center for the vendor). *See* for example, Application, p. 12, lines 3-29. Except for the use of the words "PIN" and "Payment", Wagner is drastically different from the present invention. Wagner makes no mention or notion of a closed network.

The present invention, from a closed network (e.g. of the GSM type) allows the user to purchase goods or services in an open network. Moreover, the present invention serves to bridge information between the closed network and the open network, avoiding redundant information entry on the open network that is already known to the closed network. Wagner '967 uses a web server (see Col. 10, line 1) and a Common Gateway Interface (CGI) for non-standard terminals to initiate, generate, or parse responses to commands on a terminal directly Internet connected or Internet connected via a PC using an HTML language which is here specifically extended. Wagner '967 discloses

"The preferred format for the INPUT tag which is used to identify input operations is also shown in FIG. 2. The TYPE and NAME attributes are used to define a non-standard I/O device or local storage variable for the input of

data. The TYPE field values "text," "password," "checkbox," "radio," "submit," and "reset" are previously known, as are the attributes NAME, VALUE, CHECKED, SIZE, and MAXLENGTH. To support the extended capability of the present invention, the TYPE attribute preferably includes attributes MSRT1 for reading track 1 of a magnetic swipe reader, MSRT2 for reading a magnetic swipe reader track 2, KEY for reading input from a terminal command keypad, PIN for reading a personal identification number pad, BCW for reading a bar code wand, MICR for reading a check magnetic code reader, ATM for reading a dollar amount via a key input mask, INT for reading an integer via a key input mask, LOCAL for reading input from a variable in the local storage of an I/O device, and AUTOSUBMIT for returning a FORM with information to the server."

See Col. 12, lines 18-36 (emphasis added).

Wagner makes no disclosure or suggestion of a closed network. With no disclosure or suggestion of a closed network, Wagner makes no disclosure or suggestion of bridging information known to the closed network to validate a purchase on an open network. Wagner certainly makes no disclosure or suggestion that the closed network should make re-use of user identification/authentication information to validate a purchase on an open network.

B. THERE IS NO SUGGESTION TO COMBINE THE TEACHINGS OF THE FOUGNIES PATENT WITH THOSE OF THE WAGNER PATENT.

In the Office Action, the alleged teachings of the Fougnes patent are combined with the alleged teachings of Wagner '967 to reject claims 1-22 of the present invention under 35 U.S.C. §103(a) as being unpatentable. However, to properly reject a claim based upon a combination of references, "There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself." In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). However, neither the Fougnes patent nor Wagner '967 contain any suggestion or motivation for making the suggested combination.

As can be seen from the discussion above, Wagner '967 is quite unconnected with the present invention. Wagner '967 is also unrelated to the Fougnes patent. The suggested combination

of the alleged teachings of the Fournies patent with the alleged teachings of Wagner '967 is not at all obvious or natural. The fact that Wagner '967 teaches open networks does not disclose or suggest any bridging or transmission of information from the closed network to the open network. Moreover, the suggested combination is unjustified and unfounded. Neither reference suggests any motivation for the combination. The disclosure of the present application is the motivation, and the combination of the cited references is made based on a hindsight reconstruction in light of the present disclosure.

Wagner '967 relates to data transaction systems using non-standard input/output devices.

"To establish a prima facie case of obviousness, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

See M.P.E.P. §2142. The Office Action points to no language in either the Fournies patent or the Wagner patent teaching or suggesting a basis for making such a combination. Moreover, no such suggestion or teaching is present in either case. Instead, the Office Action states, "Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fournies et al's inventive concept to include Wagner's concept of a supplier within an open network because this would have supported electronic transaction or data compilation in a secure manner without undue limitation as to the devices with which communication may be made." Fournies only teaches a method of securing payment for the closed network time that a device is used on the closed network. The concept proposed by the Office Action, (i.e., to not unduly limit the devices with which communication may be made), has little or no applicability to purchasing airtime on closed networks, wherein devices are commonly dedicated to the closed network. Further, the present invention is not the use of an open network device on a closed network, but rather the use of a closed network device on an open network. Neither Fournies nor Wagner suggest the combination proposed by the Office Action. Therefore, the suggested combination would not have been obvious to a worker skilled in the art at the time the invention was made. The rejection of all claims, based upon combining Fournies with Wagner, should be reversed.

C. FOUNGIES, ALONE OR IN COMBINATION WITH WAGNER, DOES NOT DISCLOSE OR SUGGEST THE LIMITATIONS OF CLAIM 3.

Claim 3 depends from claim 2, and further requires that the subscriber authentication step itself comprises: supplying a random number from the management center/payment server/control center to the mobile radiotelephone; the mobile radiotelephone generating and transmitting a subscriber's electronic signature, with an individual authentication algorithm and/or an individual authentication key contained in protected areas of the mobile radiotelephone, and using the random number, with the management center/payment server/control center checking the electronic signature. The final Office Action rejected claim 3, citing to Fougnes at the abstract, fig 1, 2 and column 3, line 50 - column 4, line 56. However, neither the ANI nor the DNIS of Fougnes are a random number supplied to the mobile radiotelephone or an electronic signature using the random number. The rejection of claim 3, unsupported by any disclosure from Fougnes, should be reversed. Claim 15 depends from claim 3, the rejection of which should be reversed for the same reasons, among others.

D. FOUNGIES, ALONE OR IN COMBINATION WITH WAGNER, DOES NOT DISCLOSE OR SUGGEST THE LIMITATIONS OF CLAIMS 6-9.

Claim 6 depends from claims 4 and 1, and further requires that the buyer be permitted to input a confidential payment code into the mobile radiotelephone, using a keypad associated with the mobile radiotelephone, which then sends a secure transmission of the confidential payment code to the management center/payment server/control center, which checks the confidential payment code. Claims 8 and 9 depend from claim 6. Claim 7 depends from claim 5, and further requires that the buyer inputs a confidential payment code into the mobile radiotelephone using a keypad associated with the mobile radiotelephone. The final Office Action rejected claim 6, citing to Fougnes at column 6, lines 7-27. The final Office Action rejected claim 7, citing to Fougnes at the abstract, fig 1, 2 and column 3, line 50 - column 4, line 56. However, neither the ANI nor the DNIS of Fougnes are a confidential payment code input into the mobile radiotelephone by the buyer using

the keypad. The rejection of claims 6 and 7, unsupported by any disclosure from Fougnyes, should be reversed. Claims 8 and 9 depend from claim 6, the rejection of which should be reversed for the same reason, among others.

E. **FOUGNIES, ALONE OR IN COMBINATION WITH WAGNER, DOES NOT DISCLOSE OR SUGGEST THE LIMITATIONS OF CLAIM 8.**

Claim 8 depends from claims 6, 4 and 1, and further requires that the confidential payment code is input using an input algorithm stored in the said mobile radiotelephone. The final Office Action rejected claim 8, citing to Fougnyes at column 3, line 50 - column 4, line 4. There being no disclosure or suggestion of a confidential payment code input by the buyer using the keypad in Fougnyes, there is clearly no disclosure or suggestion of an input algorithm stored in the mobile radiotelephone for inputting the confidential payment code. The rejection of claim 8, unsupported by any disclosure from Fougnyes, should be reversed.

F. **FOUGNIES, ALONE OR IN COMBINATION WITH WAGNER, DOES NOT DISCLOSE OR SUGGEST THE LIMITATIONS OF CLAIM 9.**

Claim 9 depends from claims 6, 4 and 1, and further requires the confidential payment code to be input made using at least one downloaded page in the HDML or an equivalent format provided for this purpose. The final Office Action rejected claim 9, citing to Fougnyes at column 3, line 50 - column 4, line 4. There being no disclosure or suggestion of a confidential payment code input by the buyer using the keypad in Fougnyes, there is clearly no disclosure or suggestion of using at least one downloaded page in the HDML or an equivalent format provided for this purpose for inputting the confidential payment code. The rejection of claim 9, unsupported by any disclosure from Fougnyes, should be reversed.

G. **FOUGNIES, ALONE OR IN COMBINATION WITH WAGNER, DOES NOT DISCLOSE OR SUGGEST THE LIMITATIONS OF CLAIM 14.**

Claim 14 depends from claim 1, and further requires that the mobile radiotelephone be unlocked when a comparison between a confidential identification code (PIN code) contained in protected areas of the mobile radiotelephone, and a secret key known to the buyer and input by the buyer into the mobile radiotelephone using a keypad, is positive. The final Office Action rejected claim 14, citing to Fournies at column 7, line 44 - column 8, line 40. However, neither the ANI nor the DNIS of Fournies are a secret key known to the buyer and input by the buyer into the mobile radiotelephone using a keypad. The rejection of claim 14, unsupported by any disclosure from Fournies, should be reversed.

H. **FOUGNIES, ALONE OR IN COMBINATION WITH WAGNER, DOES NOT DISCLOSE OR SUGGEST THE LIMITATIONS OF CLAIM 19.**

Claim 19 depends from claims 18 and 1, and further requires that buyer be associated with an electronic wallet which includes a confidential payment code known to the said buyer. The final Office Action rejected claim 19, citing to Fournies at the abstract, fig 1, 2 and column 3, line 50 - column 4, line 56. However, none of this discussion in Fournies relates to an electronic wallet, much less an electronic wallet which includes a confidential payment code, much less an electronic wallet which includes a confidential payment code known to the buyer. The rejection of claim 19, unsupported by any disclosure from Fournies, should be reversed.

I. **CONCLUSION**

The present invention is directed to a method or process for making secure remote payments for the purchase of goods and/or services (from an open network) via a mobile phone (connected through a closed type radiocommunications network). The elements of the present invention are not taught, suggested, or disclosed by either the Fournies patent or the Wagner patent. Moreover, there is no suggestion or motivation to combine the two references within their disclosures. The only motivation to make such a combination comes from the disclosure of the present invention, and the combination is nothing more than a hindsight reconstruction based on the

Inventor: Arnaud Capitant et al.

Appln. No.: 09/322,489

-17-

Applicant's disclosure. Therefore, the rejection of claims 1-22 under 35 U.S.C. §103(a) is inappropriate and should be withdrawn.

Respectfully submitted,

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Appendix A

Pending claims 1-22 are as follows:

1. (Previously Amended) Process for remote and secure payment for goods and/or a service purchased by a buyer from a supplier within an open network, making use of a mobile radiotelephone within a closed radiocommunications network used by the buyer, the mobile radiotelephone enabling access to the closed radio communications network managed by a management center, a payment server being connected to the closed radio communications network, characterized in that the process includes the following step:

identification of the buyer by the management center and/or the payment server and/or a control center based on a request from the supplier within the open network, the buyer identification consisting of making sure that the buyer is a subscriber correctly registered on a list of subscribers to the closed radio communications network.

2. (Previously Amended): Process according to claim 1, characterized in that the said buyer identification step itself includes the following steps in sequence:

subscriber identification, enabling the said management center and/or the said payment server and/or the said control center to receive a subscriber identifier specific to the said buyer, as a user of the said radio communications network;

subscriber authentication, enabling the said management center and/or the said payment server and/or the said control center to check the said

subscriber identifier that was sent to it (them) during the said subscriber identification step.

3. (Previously Amended) Process according to claim 2, characterized in that the said subscriber authentication step itself comprises the following steps:

the said management center and/or the said payment server and/or the said control center supplies a random number to the said mobile radiotelephone;

the said mobile radiotelephone generates a subscriber's electronic signature: with an individual authentication algorithm and/or an individual authentication key contained in protected areas of the mobile radiotelephone, and

using the said random number;

the mobile radiotelephone transmits the said subscriber's electronic signature to the said management center and/or to the said payment server and/or to the said control center;

the said management center and/or the said payment server and/or the said control center checks the said subscriber's electronic signature.

4. (Previously Amended) Process according to claim 1, characterized in that the said process also includes the following step:

the said management center and/or the said payment server and/or the said control center authenticates the said buyer, and possibly a decision to purchase the goods and/or service purchased by the buyer.

5. (Previously Amended) Process according to claim 4, characterized in that the said buyer authentication step, and possibly the purchase decision, itself comprises the following steps:

the mobile radiotelephone generates a buyer's electronic signature;
the mobile radiotelephone sends the said buyer's electronic signature to the said management center and/or the said payment server and/or the said control center;
the said management center and/or the said payment server and/or the said control center checks the said buyer's electronic signature, the said buyer's electronic signature being kept available for use by the buyer and the supplier.

6. (Previously Amended) Process according to claim 4, characterized in that the said buyer authentication step, and possibly the purchase decision step, itself comprises the following steps:

the buyer may input a confidential payment code into the mobile radiotelephone,
using a keypad associated with the mobile radiotelephone;
the mobile radiotelephone sends a secure transmission of the said confidential
payment code to the said management center and/or the said
payment server and/or the said control center;
the said management center and/or the said payment server and/or the said control
center checks the said confidential payment code.

7. (Previously Amended) Process according to claim 5, characterized in that the said buyer authentication step, and possibly the purchase decision, also comprises the following preliminary step:

the buyer inputs a confidential payment code into the mobile radiotelephone using
a keypad associated with the mobile radiotelephone.

8. (Previously Amended) Process according to claim 6 characterized in that the said step in which the said confidential payment code is input, is made using an input algorithm stored in the said mobile radiotelephone.

9. (Previously Amended) Process according to claim 6 characterized in that the said step in which the said confidential payment code is input, is made using at least one downloaded page in the HDML or an equivalent format provided for this purpose.

10. (Previously Amended) Process according to claim 5, characterized in that the said step in which the buyer's electronic signature is generated is carried out:

using a payment security algorithm and/or a payment security key contained in the
protected areas of the mobile radiotelephone, and
starting from data about the transaction and/or data about the buyer.

11. (Original) Process according to claim 10, characterized in that at least some of the said data related to the transaction include a variability.

12. (Previously Amended) Process according to claim 10, the said mobile radiotelephone comprising a terminal cooperating with a subscriber identification module, characterized in that the said payment security algorithm and/or the said payment security key is (are) stored in protected areas of the said terminal.

13. (Previously Amended) Process according to claim 10, the said mobile radiotelephone comprising a terminal cooperating with a subscriber identification module, characterized in that the said payment security algorithm and/or the said payment security key is (are) stored in protected areas of the said subscriber identification module.

14. (Previously Amended) Process according to claim 1, characterized in that it also comprises the following step:

the mobile radiotelephone is unlocked if a comparison between a confidential identification code (PIN code) contained in protected areas of the mobile radiotelephone, and a secret key known to the buyer and input by the buyer into the mobile radiotelephone using a keypad, is positive.

15. (Previously Amended) Process according to claim 3, the said mobile radiotelephone comprising a terminal cooperating with a subscriber identification module, characterized in that at least one some of the said protected areas of the mobile radiotelephone are included in the said subscriber identification module.

16. (Previously Amended) Process according to claim 1, characterized in that it also comprises the following step:

data related to payment for the purchase of goods and/or the service are encrypted, exchanged between the mobile radiotelephone and the management center and/or the payment server and/or the control center, to ensure that the purchase is confidential.

17. (Previously Amended) Process according to claim 1, characterized in that it also comprises the following step:

a check of the integrity of data related to payment for the purchase of goods and/or the service exchanged between the mobile radiotelephone and the management center and/or the payment server and/or the control center, so that a defrauder is unable to modify the said data.

18. (Previously Amended) Process according to claim 1, characterized in that the said buyer is associated with an electronic wallet comprising:

a wallet identifier associated with a subscriber identifier specific to the said buyer, as a user of the said radio communications network;
means of payment;
information about the said buyer and/or the account(s) of the said buyer;

use of the said means of payment, particularly when buying goods and/or a service not being authorized until the buyer has been successfully identified, and possibly authenticated.

19. (Previously Amended) Process according to claim 18, characterized in that the said electronic wallet also comprises:

a confidential payment code known to the said buyer.

20. (Previously Amended) Process according to claim 18, the said mobile radiotelephone comprising a terminal cooperating with a subscriber identification module, characterized in that the said electronic wallet is stored in one of the elements belonging to the group consisting of:

the said terminal;

the said subscriber identification module;

the said payment server;

the said management center;

the said control center.

21. (Previously Amended) System for remote payment of goods and/or a service purchased by a buyer from a supplier, in a secure manner using a mobile radiotelephone used by the said buyer, the said mobile radiotelephone providing access to a radio communications network managed by a management center, a payment server being connected to the said radio communications network, characterized in that the said system comprises means of implementing the process according to claim 1.

22. (Previously Amended) Mobile radiotelephone used by a buyer for remote payment of goods and/or a service purchased by a buyer from a supplier, in a secure manner using a mobile radiotelephone used by the said buyer, the said mobile radiotelephone providing access to a radio communications network managed by a management center, a payment server being connected to the

said radio communications at work, characterized in that the said radiotelephone comprises means of implementing the process according to claim 1.

Inventor: Arnaud Capitant et al.

Appln. No.: 09/322,489

-27-

Appendix B

1. U.S. Patent No. 6,236,851 to Fougnes et al.
2. U.S. Patent No. 6,366,967 to Wagner.

Inventor: Arnaud Capitant et al.

Appln. No.: 09/322,489

-29-

[General Notes]

3 copies of the brief must be filed.

Fee must be submitted with brief.

"****" denotes a section which is not required by MPEP § 1206.